

10-07-04

3713/IRW

Ser. No.: 09/934,912
Page 1 of 1**IN REPLY TO UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor : **BENNETT, Nicholas Luke**

Title : **A Gaming Machine with Multi-dimensional Symbols**

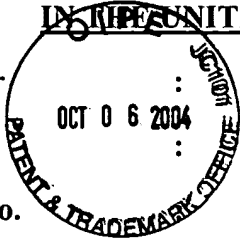
Serial No. : **09/934,912**

Confirmation No. : **8428**

Filed : **08/22/2001**

Examiner : **Michael W O'Neill**

Group Art Unit : **3713**



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PETITION UNDER 37 CFR § 1.181(A)
REQUESTING
WITHDRAWAL OF HOLDING OF ABANDONMENT

To the Commissioner for Patents:

Applicant received a Notice of Abandonment mailed September 30, 2004 for the above-referenced application. The Notice of Abandonment indicated that the current application became abandoned as a result of "[a]pplicant's failure to timely file a proper reply to the Office letter mailed on 23 February 2004." However, Applicant filed a timely response to the Office Action on July 6, 2004 with a petition for an extension of time of two months.

On July 6, 2004, the applicant filed an amendment in response to the Office Action. The Amendment was filed by facsimile transmission with a Certificate of Facsimile Transmission thereon.

Applicant is enclosing herewith a copy of the amendment and petition for extension of time filed on July 6, 2004 with the Certificate of Facsimile Transmission thereon. Applicant also is enclosing a copy of the facsimile transmission confirmation generated by it's fax machine showing successful transmission of the fax together with a copy of the Auto-Reply Facsimile Transmission received from the USPTO indicating receipt of the facsimile transmission on July 6, 2004 at 4:34:18 PM [Eastern Daylight Time].

In view of the foregoing, it is respectfully requested that the abandonment of the current application be withdrawn and Applicant's Amendment entered and examined.

As the abandonment of the current application appears to be a result of an Office error, it is believed that no fee is due with this paper. However, if any fee is due with this petition, it may be charged on Deposit Account No. 50-1290.

Please direct any inquiries regarding this petition to the Applicant's undersigned attorney, who may be reached directly by telephone at (212)940-8712.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Linda S. Chan', written over a horizontal line.

Linda S. Chan
Reg. No. 42,400

Attorney Docket No.: **3243/FBR (031035-87575)**

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1 Examiner Bennett, Nicholas Luke	USPTO – GAU 3713 Re: 09/934,912 Confirmation No. 8428	1-703-872-9306	

Date	Client/Matter Number
July 6, 2004	3243/FBR (031035-87575)
From	Attorney Number
Robert W. Hahl	34418
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212.940.6634	212.940-8986

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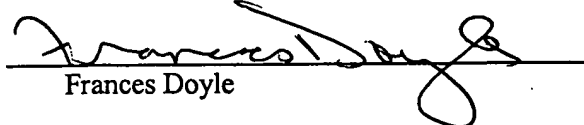
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Frances Doyle

Docket No: 031035-87575(3243/FBR)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: **Bennett, Nicholas Luke**

Application No.: 09/934,912

Group Art Unit: 3713

Filed: August 22, 2001

Examiner: Christina M Marks

For: **A Gaming Machine with Multi-dimensional Symbols**

Confirmation No. 8428

July 6, 2004

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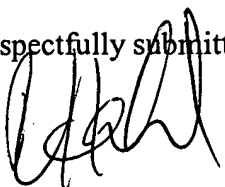
PETITION FOR EXTENSION OF TIME

Sir:

Applicant requests that the time for taking action in this case be extended pursuant to 37 CFR 1.136(a) for two months.

Any fee due with this paper, including the extension fee in the amount of \$420.00, may be charged to Deposit Account No. 50-1290.

Respectfully submitted,


Robert W. Hahl, PhD
Reg. No. 33,893

CUSTOMER NUMBER 026304
Telephone: (212) 940-8703
Fax (212) 940-8986
Docket No.: 031035-87575 (3243/FBR)
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Frances Doyle

Docket No: 031035-87575(3243/FBR)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: **Bennett, Nicholas Luke**

Application No.: 09/934,912

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Filed: August 22, 2001

Examiner: Christina M Marks

For: **A Gaming Machine with Multi-dimensional Symbols**

Confirmation No. 8428

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

July 6, 2004

AMENDMENT

Sir,

Applicant hereby petitions for a two-month extension of time, a petition pursuant to 37 C.F.R. 1.136(a) and authorization to charge the requisite fee being enclosed.

In response to the Office Action dated February 23, 2004, please amend the above referenced application as follows:

AMENDMENTS TO THE CLAIMS:

1. (currently amended): A gaming machine having a display means and a game control means arranged to control images displayed on the display means, the game control means being arranged to play a game wherein at least one random event is caused to be displayed on the display means and, if a predefined winning event occurs, the machine awards a prize, ~~the gaming machine being characterised in that~~wherein

the display means displays a plurality of movable symbol carriers;₁

each of at least certain of the carriers carrying a two dimensional symbol which is a representation of at least one polyhedral element, each polyhedral element having a plurality of faces which are visible at any one time with an indicium being carried on each face; and

indicia on at least two of the visible faces of each of the polyhedral elements which are visible at a rest condition of the carriers being taken into consideration in the determination of whether or not a winning event has occurred.

2. (currently amended): The gaming machine of claim 1 in which

the display means is a video display unit; and

the carriers are video simulations of movable carriers with video simulations of the polyhedral elements thereon.

3. (original): The gaming machine of claim 1 in which each carrier has more than one polyhedral element.

4. (original) The gaming machine of claim 3 in which the polyhedral elements are spaced from each other on each carrier such that only one polyhedral element is visible at a time when the carrier is at rest.

5. (original): The gaming machine of claim 1 in which the game is a spinning reel game.

6. (original): The gaming machine of claim 5 in which each carrier is in the form of a spinning reel carrying at least one of the polyhedral elements thereon.

7. (original): The gaming machine of claim 1 in which each element is fixed with respect to its associated carrier.

8. (original): The gaming machine of claim 1 in which at least certain of the elements are movable with respect to their associated carriers.

9. (original): The gaming machine of claim 8 in which each of said at least certain of the elements is rotatable about at least two axes, an axis parallel to a direction of movement of its associated carrier and an axis transverse to the direction of movement of its associated carrier.

10. (original): The gaming machine of claim 1 in which each element is displayed in a three dimensional format so that at least three faces are visible.

11. (original): The gaming machine of claim 1 in which the indicia carried on the faces of the elements are standard symbols related to the game.

12. (original): The gaming machine of claim 1 in which the indicia carried on the faces of the elements are special symbols in respect of the game.

13. (original): The gaming machine of claim 1 in which each polyhedral element is substantially cubic in shape.

Amendments to the Drawings:

An amended sheet 2 of the drawings with the blocks of Fig. 2 labelled is attached.

Remarks

Claims 1-13 were originally filed in this application. In this response, claim 1 has been amended and claim 2 has been corrected. No claims have been deleted or added. Consequently, claims 1-13 remain under consideration. Support for the amendments to claim 1 can be found at page 4, lines 10-22 and page 4, lines 31-36 of the specification and in the drawings. Therefore, no new matter has been added. Amendment of a claim is not to be construed as a dedication to the public of any subject matter.

The Examiner has objected to the drawings under 37 CFR 1.83(a) allegedly because the drawings fail to show the control means as described in the specification. A corrected Sheet 2 of the drawings, containing Fig. 2 with the relevant blocks labelled is attached. It is submitted that the control means is shown as the controller in Figure 2 of the drawings and that this objection has been overcome.

The Examiner has objected to claims 1-2 because of an informality in terms of 37 CFR § 1.75(i). Claims 1 and 2 have been corrected and it is submitted that this objection has been overcome.

Claims 1, 3-8, 11 and 13 stand rejected under 35 U.S.C. 102(b) as being anticipated by British Patent No. GB 2253300 to Johnston (referred to below as "Johnston").

More particularly, the office action states that:

Johnston discloses a gaming machine having a display means and a control means arranged to control images on the display (FIG 5) wherein random events cause the images to be displayed and if a predefined winning event occurs a prize will be awarded. The display means displays a plurality of movable carriers wherein each has at least on polyhedral element with a plurality of faces that are visible at any one time (FIG 5). Each face has indicia on each face and indicia on faces of the polyhedral element that are visible at a rest condition are taken into account for determining winnings.

The present invention as claimed explicitly claims that the symbol carrier carries *a two dimensional symbol which is a representation of a polyhedral element*. In contrast, Johnston

states, at page 8, lines 22-24, that the second movable means is a cube 16. Johnston therefore discloses a three dimensional, mechanical symbol carrier and does not teach a "two dimensional symbol" which is a representation of a polyhedral element as is claimed in claim 1 of the present application.

Further, as is explicitly stated, for example, in the abstract of Johnston, the bodies (16) are movable relative to the reels (7) so that each body can present a selected **one of its symbols into view at the display location.** (Applicant's emphasis). Also, as illustrated in Figure 5 of the drawings of Johnston, when viewed end on, only a single face of each cube 16 is visible at any one time so that in Johnston it is not possible that at least two of the visible faces of the polyhedral elements which are visible at a rest condition of the carriers can be taken into consideration when determining whether or not a winning event has occurred.

Claims 1-6, 8-11 and 13 stand rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,120,377 to McGinnis, Sr. et al. (referred to below as "McGinnis").

More particularly, the office action states that:

McGinnis et al. disclose a gaming machine with a video display and a game control means arranged to control images displayed. The game control means has at least one random event to be displayed and if a predefined winning event occurs, the machine awards a prize. The display means has a plurality of movable carriers which are video simulations of actual carriers and each carrier carries a representation of at least one polyhedral element having a plurality of faces which are visible at any one time with indicia being carried on each face and the indicia which are visible at a rest condition are used in determining winning events (FIG 5).

Once again, it is respectfully submitted that McGinnis does not constitute an anticipatory citation. Claim 1, as presently claimed, explicitly claims that the display means displays *a plurality of movable symbol carriers* and, further, that at least certain of the carriers carry *a two dimensional symbol which is a representation of a polyhedral element.*

With respect, McGinnis does not disclose that there are symbol carriers each carrying a two dimensional symbol which is a representation of a polyhedral element. Rather, the

symbol carriers of McGinnis are, themselves, the representations of the polyhedral elements. In this regard, see symbols S1-S4 in Figure 5 of McGinnis.

Additionally, the present invention as claimed claims that *indicia on at least two of the visible faces of each of the polyhedral elements which are visible at a rest condition of the carriers are taken into consideration in the determination of whether or not a winning event has occurred*. McGinnis explicitly teaches that only a single face of each symbol is applicable in determining a winning condition. For example, at column 3, lines 21-23, it is specified that, in the first primary set a total of three symbols - S1, S5, S2 are included in the first primary set 10 and three symbols S3, S5 and S4 are included in the second primary set. This is despite the fact that 6-sided dice are being used to generate the symbols.

The embodiment of McGinnis shown in Figure 5 of the drawings makes use of 20-sided dice. However, once again, in this embodiment only the front symbol of each die is taken into consideration in determining whether or not a winning condition has occurred. For example, if reference is made to Figure 5 of McGinnis it will be apparent that an ace symbol appears on the front face of each symbol S1-S5. It is stated at column 8, line 21 that "all dice depicting the same exact face" are taken into consideration in determining the combinations of McGinnis. Further, at column 8, lines 44-47 it is specified that, with reference to Figure 5 of the drawings a completed round of play is shown where a three-of-a-kind combination has been generated in both primary sets 10 and 12.

If one has reference to Figure 5 of the drawings, it will be readily apparent that, if other faces of the twenty-sided dice S1-S5 were to be taken into consideration, other winning combinations would also be present, viz. a three-of-a-kind win for each of the symbols "10" and "K" on S3, S4 and S5 and, similarly, for S1-S5 and S2. This is quite evidently not the case in McGinnis so that only the indicia on the front faces of the dice are applicable in determining a winning event. Therefore, it is only the "A" indicium on each front face that is

applicable in determining the winning event in McGinnis. Thus, McGinnis does not teach that *indicia on at least two of the visible faces on each of the polyhedral elements which are visible at a rest condition of the carriers being taken into consideration in the determination of whether or not a winning event has occurred.*

It is well established that, in respect of a novelty objection, the prior art must disclose all the integers of the invention as claimed. ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).

It is respectfully submitted therefore that, as neither Johnston nor McGinnis disclose all the features of claim 1 as presently claimed, neither citation constitutes an anticipation. In view of the fact that the remaining claims depend directly or indirectly from claim 1, neither Johnston nor McGinnis constitutes an anticipatory citation against any of the dependent claims either.

Claims 4 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston.

As indicated above, Johnston does not teach, hint or suggest all the integers of claim 1 as presently claimed. Both claims 4 and 12 depend directly or indirectly from claim 1. In the circumstances, it is respectfully submitted, that what is claimed in claims 4 and 12 is inventive over the teachings of Johnston.

Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over McGinnis.

For the reasons canvassed above, McGinnis does not disclose all the integers of claim 1 as presently claimed. Claim 12 depends directly or indirectly from claim 1. In the circumstances, it is respectfully submitted that what is claimed in claim 12 is patentably distinguishable over the teachings of McGinnis.

Further, insofar as claim 12 is concerned, neither Johnston nor McGinnis discloses, teaches or suggests, in any way whatsoever, whether explicitly or implicitly, that any of the symbols displayed can be special symbols. The Examiner is, with respect, relying on the benefit of hindsight in order to allege that it would be obvious to one of ordinary skill in the art to incorporate special symbols, such as a wild symbol, into the systems of Johnston or McGinnis.

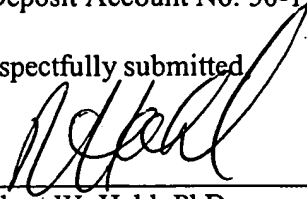
Conclusion

Applicant has fully responded to each matter of substance raised in the Office Action and believes that the case is in condition for allowance. Withdrawal of the rejections and allowance of the application is therefore courteously solicited. Should the Examiner have any requests, questions or suggestions, the Examiner is invited to contact Applicant's attorney at the number listed below.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

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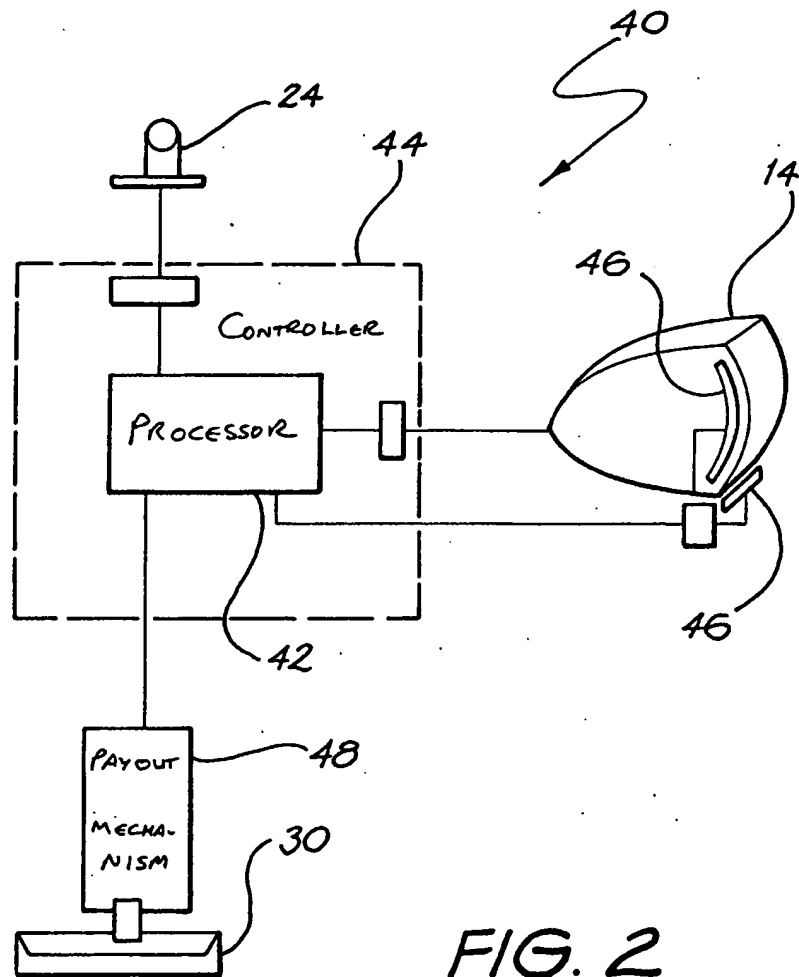
Respectfully submitted



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2/6



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